

REMARKS

In this application, claims 44-62 are pending. In the pending Office Action, Examiner Swiger made a restriction requirement between two identified groups of claims, which were characterized as follows:

Group I: Claims 44-58, drawn to a medical apparatus, classified in class 606, subclass 72.

Group II: Claims 59-62, drawn to a method, classified in class 606, subclass 61.

The above language concerning the Examiner's groups is taken verbatim from the Office Action for the sake of clarity, and is not intended as an admission of any sort by Applicants as to the subject matter or classification of any claim.

As Examiner Swiger's restriction requirement relied on the provisions of 35 U.S.C. § 121, which makes restriction permissive, per standard PTO practice noted in MPEP 803 and 808.02 this application should be examined as a whole if it can be done without undue burden on the examiner. Accordingly, Applicants elect Group I (claims 44-58) for prosecution, with traverse on the grounds that searching and examining the entire application can be made without serious burden. Respectfully, the searching required for group I will include class 606, subclass 61, which the Office Action suggests to be the classification of group II. Thus, any searching required for claim group I will include the material which must be searched for claim group II. Further, method claims 59-62 recite a receiver member and a retaining member similar to those recited in claim 1. Thus, the references that are relevant to the group I claims, if any, will likely include any references relevant to the group II claims. Since the research and analysis effort required for examining the group I claims will provide the references and analysis for examining the group II claims, it is respectfully submitted that there will be no significant extra burden in

searching and examining both sets of claims. Per MPEP 803 and 808.02, the restriction requirement should be withdrawn and all pending claims should be examined.

Additionally, Examiner Swiger has not provided reasonable examples that recite material differences between Groups I and II as required by MPEP 806.05(e). No reasoning has been given to support the election requirement other than the allegation that the groups “are related as process and apparatus for its practice.” The Office Action further asserts that the groups are “independent or distinct for the reasons given above.” These statements are entirely conclusory in nature. No particular aspects of the claims have been suggested in the Office Action as supporting those conclusions. Per MPEP 803 and 808.01, the restriction requirement should be withdrawn and all pending claims should be examined.

The pending Office Action also made a requirement for election of species. This requirement is also traversed. Examiner Swiger indicated his opinion that the present application includes claims directed to more than one species. Specifically, the following species were identified:

A) Fig. 5b

B) Fig. 5c

The above language concerning Examiner Swiger’s categorization is taken verbatim from the Office Action for the sake of clarity, and is not intended as an admission of any sort by Applicants as to the subject matter of any claim. The Examiner requested an election between these asserted species, but did not observe the genericness of several of the claims.

It is respectfully submitted that the election requirement should be withdrawn, principally because a proper *prima facie* case for the requirement has not been established. The sole basis for the requirement was that each of the alleged species “could be used in a different

combination to create a patentably distinct device.” However, no facts or other basis for that conclusion were given in the Office Action. “The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate.” MPEP 808.01 (emphasis added); see also MPEP 803 (“Examiners must provide reasons and/or examples to support conclusions). No citation to the application, discussion of the embodiments, or other evidence or grounds for that conclusion were provided. As noted above, the MPEP defines as inadequate the conclusion of restrictability without basis. Respectfully, the requirement should be withdrawn on at least this basis.

Additionally, the Office Action relied on the provisions of 35 U.S.C. § 121, which makes restriction permissive, in requesting that Applicant elect a single species. Section 121 permits limitation to a “reasonable number” of species. The embodiments shown and described in this application are a reasonable number for consideration, and the election requirement does not suggest otherwise. Further, the similarities among the embodiments are such that they can all be efficiently considered together when the claims are searched and examined. If “the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among independent or related inventions.” MPEP 808.02. The Office Action does not allege that the classification of the alleged species is different, and it seems likely that all such species would be commonly classified. The Office Action asserts the bare conclusion that different combinations may produce patentable distinction, but does not provide any examples or evidence. It is not apparent from the record that any searching would be necessary for one species “that is not likely to find art pertinent to the other[s].” *Id.* Rather, it is believed that any practical and reasonable search

strategy for one species would find references pertinent to all species. Finally, no suggestion was provided that the alleged species would be separately classified or searchable in the future. No patents or other evidence of a separate field of search was provided, as MPEP 808.02 requires. A proper election requirement “must show by appropriate explanation” (1) separate classification, (2) separate status in the art, or (3) a different field of search. *Id.* Because the Office Action does not provide the necessary evidence and explanation, the election requirement should be withdrawn.

The Examiner has further requested a listing of the pending claims that read on the provisionally-elected species. That request is respectfully objected to as improperly devolving the responsibilities of the PTO onto the Applicants. The PTO has the burden of proof to provide evidence and a sufficient showing that claims in an application are unpatentable, or should otherwise be excluded from an application.

So as to give a complete response for the sake of efficiency, species A (Figure 5b) is provisionally elected, **with traverse**. Given the breadth of the specification and the claims, all of the pending claims read on that subject matter. Further, insofar as none of the differences between Fig. 5b and Fig. 5c are specifically recited in any of the pending claims, it is maintained that all of the pending claims are generic to the species of Figs. 5b and 5c alleged in the election requirement.

Applicants do not concede the propriety of the Examiner’s request, and do not intend to limit in any way the scope of the claims or this application with the statements or provisional election herein. Specifically, the claims in this application should be given the full scope permitted by their language. Applicants reserve the right to later assert that other claims are

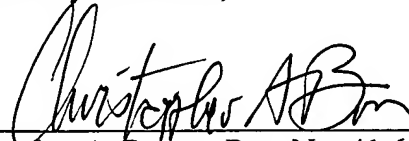
generic or read on the provisionally-elected species as well, especially if the election requirement is not withdrawn.

Traversal is based at least on the lack of support for the election requirement, the lack of significant extra burden in examining all claims, the fact that there is no showing that the alleged species constitute an unreasonable number, and the presence of generic claims to several of the alleged species. For at least these reasons, the election requirement should be withdrawn, and all claims should be examined.

No amendments have been made to the claims in this paper. The claims are intended to have the full scope permitted by their language.

In conclusion, Applicant has made a provisional election as noted above with traverse. Examiner Swiger is respectfully requested to reconsider the present restriction and election requirement and withdraw it. An Office Action toward a Notice of Allowance in this case is respectfully solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Christopher A. Brown", is written over a horizontal line.

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